

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* Onno Dirk Oenema, Paul Wessel Post, and  
Marco Raymond Maria Nijmeijer

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Appeal No. 2006-3187  
Application No. 09/831,334

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ON BRIEF

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Before DIXON, BARRY, and SAADAT, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This is an Order remanding this application to the Examiner. From our initial review of the application and prosecution history, we note a number of items and issues that need to be addressed and clarified by Appellants and the Examiner prior to our decision on the merits.

First, we note that Appellants' Brief is non-compliant with respect to 37 CFR 41.37(c)(1)(v) Summary of claimed subject matter. With respect to independent claim 27, Appellants state:

Independent claim 27 is directed to an electrically controlled mirror assembly for a motor vehicle. The assembly includes a mirror housing having a build-up element 1 that defines a hollow 3 and that has a reinforcing element molded therein (Figures 1 and 2; page 7, lines 27-33). A base or support 7 supports the build-up element 1 with a electromechanical means, such as a motor 9, that folds or rotates the mirror housing relative to the support (Figure 3; page 8, lines 10-24). The electromechanical means also can adjust a mirror plate 22 relative to the housing (Figure 3; page 7, lines 29-33). An electronics unit is disposed in the hollow 3 to control energization of the electromechanical means (Figure 3; page 9, lines 23-35).

Claim 27 recites:

27. An electrically controlled mirror assembly for a motor vehicle comprising:
- (a) a support adapted for mounting on a vehicle;
  - (b) a mirror housing moveably associated with said support comprising a single build-up element formed of non-conductive material with a reinforcing element insert molded therein for increasing the rigidity and strength of the build-up element, said build-up element defining a hollow;
  - (c) a mirror plate moveably associated with the housing;
  - (d) electromechanical means operable upon energization for adjusting said housing relative to said support and for adjusting said mirror plate relative to said housing;
  - (e) means operable upon electrical energization for performing an ancillary function; and,
  - (f) an electronics unit received in said hollow for controlling said energization for said adjusting.

We note that Appellants' brief is silent as to the corresponding structure acts or materials for performing function "(e) means operable upon

electrical energization for performing an ancillary function.” Therefore, Appellants’ brief is non-compliant and a new brief is required. Therefore, the Examiner should require a new brief with a correct Summary of the claimed subject matter.

As an additional note from our cursory review of Appellants’ specification, we note that the specification seems to only describe the structures for performing ancillary functions in terms of “means” rather than an actual structure which would perform the function. We leave it to the Examiner to further consider, after Appellants identify the corresponding structure, acts and materials in the specification, whether this disclosure is sufficient under 35 U.S.C. § 112, First and Second Paragraphs with the recited “(e) means operable upon electrical energization for performing an ancillary function.” The Examiner is required to take appropriate action as needed.

Any subsequent brief submitted by the appellants should be self-contained with respect to all arguments. No prior brief should be referenced or incorporated therein. Similarly, any subsequent Examiner's Answer should be self-contained with respect to all rejections and arguments; no prior answer or Office action should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).

Accordingly, it is

ORDERED that the application is returned to the examiner to:

- (1) The Examiner should notify Appellants of the non-compliant Brief and require submission of a Brief in compliance with 37 CFR 41.37;
- (2) the Examiner is required to consider Appellants' compliance with 35 U.S.C. § 112, First and Second Paragraphs, in light of the identification of corresponding structure; and
- (3) for such further action as may be appropriate.

JOSEPH L. DIXON  
Administrative Patent Judge

~~LANCE LEONARD BARRY~~  
Administrative Patent Judge

MAHSHID D. SAADAT  
Administrative Patent Judge

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